

### **REMARKS**

The present Office Action addresses and rejects claims 1-25. Reconsideration is respectfully requested in view of the following. A list of the pending claims are attached for the Examiner's convenience.

#### ***Rejections Pursuant to 35 U.S.C. § 103***

Claims 1-3, 5-7, 10-16, and 21-25 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,195,956 of Stockmeier ("Stockmeier") in view of PCT Publication No. WO 99/58066 of Altman et al. ("Altman"). Applicant respectfully disagrees.

The Examiner argues that Stockmeier discloses the claimed invention except for a cutting member disposed proximal to a harvesting tip and effective to macerate a tissue sample excised by the tissue harvesting tip. The Examiner thus relies on Altman to remedy the deficiencies of Stockmeier. Applicant respectfully disagrees.

At the outset, there is no motivation for adding a cutting member proximal to the cutting tool of Stockmeier because such a modification would provide no advantage. The strongest rationale for combining references is a recognition that some advantage or expected beneficial result would be produced by the combination. (See MPEP §2144). There is no advantage or expected beneficial result produced by modifying the device of Stockmeier to include a cutting member from the device of Altman. Claim 1 specifically requires a cutting member coupled to a shaft at a position proximal to a cutting tool. If a cutting member could be added to Stockmeier at a location proximal to the cutting tool (5), the cutting element would be fully disposed within the shaft (8). Since Stockmeier discloses no means of drawing tissue into the shaft (8), the cutting element would be an absolutely useless element since it would not cut tissue. In response to Applicants' previous arguments, the Examiner insists that as long as the prior art structure, i.e., Stockmeier modified with Altman, is capable of performing the intended use, then it meets the claim. The modified structure, however, is *not* capable of performing the intended use, namely macerating tissue. In this case, a cutting member added to Stockmeier will *never* be capable of

macerating tissue because the device is not capable of sending tissue past the cutting tool (5) and into contact with a cutting element disposed within the shaft. Adding a cutting element proximal to the cutting tool of Stockmeier would serve no purpose and provide no advantage. Thus, a person having ordinary skill in the art would never make the modification suggested by the Examiner.

Even if there was some motivation to make the modification suggested by the Examiner (which there is not), the modification could not be made without completely redesigning and reconstructing the device of Stockmeier. Stockmeier is simply not structurally capable of being modified to include a cutting member coupled to a shaft at a position proximal to a harvesting tip. As shown in Figures 1 and 2 of Stockmeier, the medical catheter is designed so that a hub (4) on the cutting tool (5) abuts against a bearing (7). There is simply no physical room for a cutting member to be added to a shaft (3) of the cutting tool (5) at a location proximal to the cutting tool (5). The Examiner's suggested modification would require a substantial reconstruction of the elements shown in Stockmeier as well as a change in the basic principle under which the device of Stockmeier was designed to operate. Accordingly, independent claim 1, as well as claims 2-3, 5-7, 10-16, and 21-25 which depend therefrom, distinguish over Stockmeier in view of Altman and represent allowable subject matter.


Dependent claims 4, 8-9, and 17-20 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over Stockmeier in view of Altman and in further view of one of various references set forth in the Office Action. At least for the reasons explained above, no person having ordinary skill in the art would modify Stockmeier to include a second cutting member located proximal to the harvesting tip. Accordingly, the remaining cited references cannot cure the deficiencies of Stockmeier. Claims 4, 8-9, and 17-20 are therefore allowable at least because they depend from an allowable base claim.

*Conclusion*

Applicant submits that all claims are in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicant if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,

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